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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,965	12/04/2001	Alain Calvet	5808-01-CA	3513
7590 01/22/2004				
Charles W Ashbrook Warner Lambert Company 2800 Plymouth Road Ann Arbor, MI 48105		EXAMINER DESAI, RITA J		
		ART UNIT PAPER NUMBER 1625		

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/980,965	Applicant(s) CALVET ET AL.	
	Examiner Rita J. Desai	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-13 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-9, 11-13 are pending.

The request filed on 12/11/03 for a Continued Examination Application (RCE) under 37 CFR 1.114 based on parent Application No. 09/980965 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Arguments

The applicants have argued the Gilligan et and Gyermek et al reference. The examiner does not find it convincing. Applicants claim is drawn to treating pain in general. Even arrhythmia has a considerable amount of pain associated with it.

The Gilligans reference by itself teaches the compounds and that they are used for treating arrhythmia. Thus in the broadest sense the reference reads on it.

The Gyermek reference clearly teaches the relationship between the receptors and Pain.

Applicants arguments are not found to be persuasive that the Gyermek reference statement is ambiguous. Examiner disagrees. The reference on the whole teaches 5HT agonists and antagonists with different pharmaceutical uses.

The claims are drawn to treating pain and in need thereof.

The prior art teaches the compounds to treat arrhythmia. The same receptors treat migraine.

Thus one would have found it obvious that to use the compounds to treat pain since both migraine and arrhythmia are both associated with pain.

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Examiner is repeating the rejection in the final rejection.

Applicants claims do not have any reference to the Na channel antagonist mechanism. The specifications teach treating pain related to acute diseases and illness.

The prior art teaches similar compounds to treat migraine and pain. Thus the method of treating is obvious over the prior art.

In re Best Bolton and Shaw, 195 USPQ 430,

Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

Applicants state that their compounds are Na channel antagonists and they treat migraine and pain . But the prior art has similar compounds and treat the same conditions. It is silent regarding the Na Channel antagonist mechanism, and applicants do not have any side by side showing that the prior art compounds do not have the Na channel antagonist properties .Thus the arguments have not been found to be convincing.

The rejection still stands.

Conclusion

This is a RCE of applicant's earlier Application No. 09/980,965. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the

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grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


1/14/04

Rita J. Desai
Primary Examiner
Art Unit 1625